

REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Claims 1-19, 21-22, and 31-37 remain pending in the present application, including independent claims 1, 12-14, and 31. Independent claim 1, for instance, is directed to a surface-modified glove. The glove comprises an elastomeric matrix in the shape of a glove that receives a human hand therein. The matrix has an inside surface for contact with a human hand received within the glove and an outside surface. A plurality of colloidal silica particles are adhered to at least a portion of the outside surface of the matrix and partially embedded therein without extending through the thickness of the matrix.

In the Office Action, independent claims 1, 12-14, and 31 were rejected under 35 U.S.C. §103(a) as being obvious over the Abstract of JP 89023565 (hereinafter "JP '565") in view of U.S. Patent No. 5,008,178 to Van Thillo, et al. JP '565 is directed to an antistatic glove that contains a cloth fiber base. A synthetic resin or rubber layer is also provided that contains rubber powder and/or grains and fine particles of conductors mixed with conductive short fibers.

As correctly noted by the Examiner, however, JP '565 fails to teach various limitations of the present claims, such as colloidal silica particles partially embedded in the outer surface of an elastomeric matrix. Nevertheless, JP '565 was combined with Van Thillo, et al. in an attempt to render obvious claims 1, 12-14, and 31. However, Applicant respectfully submits that one of ordinary skill in the art would not have been

motivated to combine these references in the manner suggested in the Office Action.

Van Thillo, et al. relates to recording materials. (Col. 1, ll. 8-12). For example, Van Thillo, et al. mentions that one problem of conventional recording materials is that, in the reeling-up or unreeling of dry photographic film in a camera or projector, high friction may build up resulting in electrostatic charges. (Col. 1, ll. 27-30). On the other hand, JP '565 relates to working gloves made from a fiber base cloth. Based on the vast differences between these types of products, one of ordinary skill in the art would simply not have been motivated to combine certain aspects of Van Thillo, et al. with JP '565.

Notwithstanding the above, the Office Action indicates that the motivation to combine Van Thillo, et al. with JP '565 stems from a desire to lower costs. Specifically, it was stated that it is "well known in the glove-making art that colloidal silica particles are inexpensive." The Office Action deems it "desirable to employ low-cost material when making products in order to keep manufacturing costs minimal." Even if this were somehow considered a proper basis for combining references, no evidence has been provided that such colloidal silica particles are actually lower in cost than the particles of JP '565. A *prima facie* case of obviousness simply has not been established.

Applicant emphasizes that the teachings of the references must be viewed in their entirety, i.e., as a whole, to sustain a *prima facie* case of obviousness under 35 U.S.C. §103(a). Further, the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. That is, the differences between a particular claim and the cited references cannot be viewed in a vacuum. In

this case, Applicant respectfully submits that, when properly viewed as a whole, there is simply no motivation to combine the references in the manner suggested in an attempt to render obvious the present claims. Thus, for at least the reasons set forth above, Applicant respectfully submits that independent claims 1, 12-14, and 31 patentably define over the above-cited references, taken alone or in any proper combination.

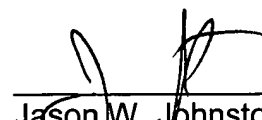
The above-cited references were also cited together and in combination with Nash to reject dependent claims 2-8, 10-11, 15-19, 21-22, 32-33, and 35-37. Applicant respectfully submits, however, that at least for the reasons indicated above with respect to independent claims 1, 12-14, and 31, dependent claims 2-8, 10-11, 15-19, 21-22, 32-33, and 35-37 patentably define over the references cited. However, Applicant also notes that the patentability of such dependent claims does not necessarily hinge on the patentability of independent claims 1, 12-14, and 31. In particular, it is believed that some or all of these claims may possess features that are independently patentable, regardless of the patentability of claims 1, 12-14, and 31.

Thus, Applicant respectfully submits that the present claims patentably define over all of the prior art of record. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Nolan is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

DORITY & MANNING, P.A.



Jason W. Johnston
Registration No. 45,675

DORITY & MANNING, P.A.
P. O. Box 1449
Greenville, SC 29602-1449
Phone: (864) 271-1592
Facsimile: (864) 233-7342

Date: 5/20/04